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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,954	03/30/2001	David W. Cannell	05725.0637-00	7371

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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,954

Applicant(s)

CANNELL ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/09/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37.39-57 and 59-79 is/are pending in the application.
- 4a) Of the above claim(s) 1-37.39-57 and 59-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 78 and 79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment filed on November 9, 2004 has been entered. Claims 1-37, 39-57, 59-79 are pending in this application. Claims 1-36, 40, 42, 44-46, 50-57, 59, 64-65 were previously withdrawn pursuant to the Restriction requirement set forth in February 22, 2002 as being directed to the non-elected invention and/or non-elected species. Claims 37, 39, 41, 43, 47-49, 60-63, 66-77 are withdrawn as being directed to non-elected species. Claims 78-79 are herein under considerations for their merits.

As the initial matter, Examiner clarifies that the only prior art rejection of record was indeed, as recognized by Applicant on the page 16 of the Amendment, over Riordan US Patent 5,866,142. Examiner expresses regret on citing a wrong Patent Number on the face of the rejection on the Office Action filed on July 14, 2004. Nevertheless, the issues is moot because the PTO-892 provided the correct patent number and the body of the rejection relied on Riordan as the reference,.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 78-79 stand rejected under 35 U.S.C. 102(b) as being anticipated by Riordan US Patent 5,866,142.

3. Applicant's arguments with respect to this rejection have been fully considered but are not persuasive. Applicant argues that not each and every element of the claims is met by the prior art reference because Riordan's ingredient is N-acetyl-D-

glucosamine and that is not a glucosamine within the scope of the instant claims. (see Arguments at page 17, 2nd –3rd para.). Indeed, Applicant appears to suggest that the claim element of “at least one glucosamine” is only directed to glucosamine HCL as used in Example 2. *Id.*

4. In response Examiner states that Applicant’s arguments are not commensurate with the scope of the claims. Applicant should note that during patent prosecution Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. See, e.g., *In re Zletz*, 893 F.2d 319, 321 - 22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). However, “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 162 USPQ 541, 550 - 51 (CCPA 1969). Here Applicant advocates the impermissible importation of subject matter from the specification into the claim.

5. Contrary to Applicant’s position the instant recitation of “at least one glucosamine” in claim 78, does not exclude the glucosamine derivatives disclosed in Riordan. In fact, the specification’s description of such term is inclusive of all derivatives and salts thereof. (see instant Specification at page 17, lines 4-5). See for example the instant specification at page 18, lines 15-19 where it describes “In one embodiment, the at least one compound is chosen from oligosaccharides derived from the at least one Cs to C7 saccharine unit substituted with at least one amino group which may be **further substituted with at least one group different from that least one amino**

group.” In fact the specification at page 17, lines 15-20 includes derivatives such as those described by Riordan by stating that **“the at least one amino group may be chosen from N-acetyl amino groups.”** Hence, Applicant claims do not exclude the glucosamine derivatives of Riordan. Thus, Applicant’s arguments are not commensurate with the scope of the claims.

6. Applicant also argues that second element of the instant claim 79 requires an unsubstituted sugar. (see Amendment at page 18, 1st para). Applicant asserts that the second element is “at least one additional sugar different from said at least one compound comprising at least one C5 to C7 saccharide unit substituted with at least one amino group and derivatives thereof, said at least one additional sugar is unsubstituted.” (Hereinafter “the second element of claim 79”) Applicant alleges that Riordan’s hyaluronic acid does not meet such limitations. *Id.*

7. In response Examiner states that again Applicant’s arguments are not commensurate with the scope of the claims. Indeed the second element of claim 79 includes a C5 to C7 saccharide unit with at least one amino group and derivatives thereof, wherein such sugar is unsubstituted. However, Hyaluronic acid of Riordan meets such limitations, because the scope of the claims does not exclude it.

8. In fact, the instant Specification describes the scope of said sugar to include oligosaccharides (see page 19, line 22-page 20, line 5). Hyaluronic acid falls within the scope of the instant sugar because it is an oligosaccharide and as a whole it is an unsubstituted sugar (see Merck Index 7th ed. pages 751-752). Further, as shown in Merck Hyaluronic acid moieties contain no substitution except at its amino group. The

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instant claims embrace the derivetized amino groups. (Attention is drawn to the recitation of "at least one amino group and derivatives thereof" in claim 79). Therefore, Hyalouronic acid of Riordan meets the second element of claim 79.

9. Moreover, Applicant's classification of Hyaluronic acid as a substituted sugar is in fact inconsistent with the arguments presented. Applicant appears to argue that the N-acetyl-D-glucosamine unit in hyalouronic acid is a substituted sugar. (see Amendment at page 18, lines 9-12). Accordingly, Applicant attempts to interpret each saccharide unit within a hyalouronic acid molecule as a sugar. Even if such interpretation of claim is employed, Hyaluronic acid of Riordan meets the second element of claim 79, because as shown in Merck Index 7th ed. 4675 at pages 751-752, hyaluronic acid polymers must contain at least two unsubstituted sugar moiety (saccaride units). (see the formula at top of page 752).

Therefore, Applicant's arguments are not found persuasive and the rejection is maintained.

Conclusion

10. **No claims are allowed. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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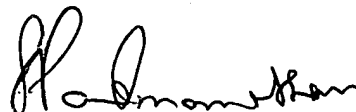
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER**